

Appl. No. 10/825,905
April 20, 2006
Response to Office action of December 20, 2005

REMARKS

Claims 1-3, 5-10, 13, 14, 16-20, and 22 remain in this application. Claims 4, 11, 12, 15, and 21 have been canceled. Claim 22 has been added.

I. CLAIM REJECTIONS - 35 U.S.C. § 103

A. Examiner's Statements

The examiner rejected claims 1-2, 5, 6, 8-11, 13, and 19-20 under 35 U.S.C. § 103(a) as being unpatentable over Wittrisch (U.S. Patent No. 4,738,312) ("Wittrisch") in view of Ludwig et al. (U.S. Patent No. 6,032,733) ("Ludwig"). The examiner rejected claims 1-2, 5, 7-9, 13, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Wittrisch in view of Lenhart (U.S. Patent No. 5,141,051) ("Lenhart"). The examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Wittrisch in view of Ludwig as applied to claim 1 and further in view of Marshall (U.S. Patent No. 4,388,969) ("Marshall"). The examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Wittrisch in view of Lenhart as applied to claim 1 and further in view of Marshall. The examiner rejected claims 14 and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over Wittrisch in view of Ludwig and further in view of Marshall. The examiner rejected claims 14, 16, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Wittrisch in view of Lenhart and further in view of Marshall.

B. Law

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹ If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

To establish a *prima facie* case of obviousness, the following tenets of patent law must be adhered to: (a) the claimed invention must be considered as a whole; (b) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (c) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (d) reasonable expectation of success is the standard with

¹ *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

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which obviousness is determined.² Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.³

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.⁴ Thus, a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.⁵ Additionally, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.⁶

Also, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.⁷ In addition, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.⁸

C. Claims 1-2, 5, 6, 8-11, 13, and 19-20

Claims 1-2, 5, 6, 8-10, 13, and 19-20 are not obvious because Wittrisch combined with Ludwig fails to teach or suggest all of the limitations of the claims. Claims 1-2, 5, 6, 8-11, 13, and 19-20 require or require using a trip bushing engageable by a re-head connected to the wireline, the trip bushing being movable by the re-head to compress a spring against a ram head secured by shear pins, and a pivotally mounted cutting device adapted to be pivoted by the ram head when released by the shear pins and cut the wireline. However, although Wittrisch discloses a pivoting cutting device, the

² *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

³ *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

⁴ *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *see also In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

⁵ *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *see also In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

⁶ *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

⁷ *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

⁸ *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959).

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cutting device is activated in a different manner. Thus, there is no *prima facie* case of obviousness because Wittrisch and Ludwig fail to teach or suggest all of the limitations of the claims. Therefore, the applicant respectfully submits that the rejection is unsupported by the art and should be removed with respect to claims 1-2, 5, 6, 8-10, 13, and 19-20.

The applicant has canceled claim 11.

D. Claims 1-2, 5, 7-9, 13, and 19

Claims 1-2, 5, 7-9, 13, and 19 are not obvious because Wittrisch combined with Lenhart fails to teach or suggest all of the limitations of the claims. Claims 1-2, 5, 7-9, 13, and 19 require or require using a trip bushing engageable by a re-head connected to the wireline, the trip bushing being movable by the re-head to compress a spring against a ram head secured by shear pins, and a pivotally mounted cutting device adapted to be pivoted by the ram head when released by the shear pins and cut the wireline. However, although Wittrisch discloses a pivoting cutting device, the cutting device is activated in a different manner. Thus, there is no *prima facie* case of obviousness because Wittrisch and Lenhart fail to teach or suggest all of the limitations of the claims. Therefore, the applicant respectfully submits that the rejection is unsupported by the art and should be removed with respect to claims 1-2, 5, 7-9, 13, and 19.

E. Claim 3

Claim 3 is not obvious because Wittrisch in view of Ludwig as applied to claim 1 and further in view of Marshall fails to teach or suggest all of the limitations of the claim. Claim 3 depends from claim 1. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.⁹ Therefore, the applicant respectfully requests that the examiner remove the rejection with respect to dependent claim 3 as well.

F. Claim 3

Claim 3 is not obvious because Wittrisch in view of Lenhart as applied to claim 1 and further in view of Marshall fails to teach or suggest all of the limitations of the claim. Claim 3 depends from claim 1. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.¹⁰ Therefore, the applicant respectfully requests that the examiner remove the rejection with respect to dependent claim 3 as well.

⁹ *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

¹⁰ *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

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G. Claims 14 and 16-17

Claims 14 and 16-17 are not obvious because Wittrisch in view of Ludwig and further in view of Marshall fail to teach or suggest all of the limitations of the claims. Claims 14 and 16-17 require or require using a trip bushing engageable by a re-head connected to the wireline, the trip bushing being movable by the re-head to compress a spring against a ram head secured by shear pins, and a pivotally mounted cutting device adapted to be pivoted by the ram head when released by the shear pins and cut the wireline. However, although Wittrisch discloses a pivoting cutting device, the cutting device is activated in a different manner. Thus, there is no *prima facie* case of obviousness because Wittrisch in view of Ludwig and further in view of Marshall fail to teach or suggest all of the limitations of the claims. Therefore, the applicant respectfully submits that the rejection is unsupported by the art and should be removed with respect to claims 14 and 16-17.

H. Claims 14, 16, and 18

Claims 14, 16, and 18 are not obvious because Wittrisch in view of Lenhart and further in view of Marshall fail to teach or suggest all of the limitations of the claims. Claims 14, 16, and 18 require or require using a trip bushing engageable by a re-head connected to the wireline, the trip bushing being movable by the re-head to compress a spring against a ram head secured by shear pins, and a pivotally mounted cutting device adapted to be pivoted by the ram head when released by the shear pins and cut the wireline. However, although Wittrisch discloses a pivoting cutting device, the cutting device is activated in a different manner. Thus, there is no *prima facie* case of obviousness because Wittrisch in view of Lenhart and further in view of Marshall fails to teach or suggest all of the limitations of the claims. Therefore, the applicant respectfully submits that the rejection is unsupported by the art and should be removed with respect to claims 14, 16, and 18. The remainder of the claims depend from claims 14, 16, and 18.

II. ALLOWABLE SUBJECT MATTER

The examiner stated that claims 4, 12, 15, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The applicant has canceled claims 4, 12, 15, and 21.

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III. STATEMENT REGARDING CLAIMS

The applicant comments on the allowability of the claims by addressing the examiner's comments in this paper as well as previously during the prosecution of this application. By doing so, the applicant is in no way limiting its ability to argue additional points of novelty regarding the independent claims or dependent claims at a later date.

CONCLUSION

The applicant respectfully requests reconsideration the pending claims and that a timely Notice of Allowance be issued in this case. If the examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

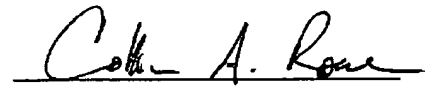
In the course of the foregoing discussions, the applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. There may also be other distinctions between the claims and the prior art that have yet to be raised, but that may be raised in the future.

Unless the applicant has specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although the applicant may have amended certain claims, the applicant has not abandoned its pursuit of obtaining the allowance of these claims as originally filed and reserves, without prejudice, the right to pursue these claims in a continuing application.

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If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769 (ref. 1391-49700) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,
CONLEY ROSE, P.C.



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